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In the

Supreme Court of the United States

OCTOBER TERM, 1971

EUGENE A. WAHL and
VIBRA SCREW FEEDERS, INC.,

Petitioners,

vs.

CARRIER MANUFACTURING CO., INC.,

Respondent.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SEVENTH CIRCUIT

EDWARD A. HAIGHT
JOHN W. HOFELDT
Attorneys for Petitioners

Of Counsel:
HAIGHT, HOFELDT & DAVIS
141 West Jackson Boulevard
Chicago, Illinois 60604

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vs.

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Respondent.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SEVENTH CIRCUIT

Petitioners, Eugene A. Wahl and Vibra Screw Feeders, Inc., respectfully pray that a Writ of Certiorari issue to review the Judgment and Opinion of the United States Court of Appeals for the Seventh Circuit entered in this proceeding on August 30, 1971.

OPINIONS BELOW

The Opinion of the Court of Appeals for the Seventh Circuit is reported at ..... F. 2d ....., 171 USPQ 195, and is reproduced in Appendix A hereto. The findings of fact and conclusions of law of the District Court for the Southern District of Indiana are not reported and are reproduced in Appendix B hereto.

JURISDICTION

The Judgment of the Court of Appeals for the Seventh Circuit was entered on August 30, 1971 (Appendix C). A timely petition for re-hearing was denied on November 2, 1971 (Appendix D). This Court's jurisdiction is invoked under 28 U.S.C., Section 1254(1).

QUESTIONS PRESENTED

1. Are the Patent Statutes complied with when patent claims are applied to cover more than their express terms permit on the issue of novelty and to cover less than their express terms require in determining that certain accused structures do not infringe?

2. Is the issue of obviousness under 35 U.S.C. 103 properly decided without consideration of the patent claims and the differences between them and the prior art?

3. Is independent development by another, without more, a basis for concluding obviousness under 35 U.S.C. 103, especially in view of the provisions of the Patent Statutes for determining which of independent inventors is entitled to priority and the grant of a patent on the invention?

THE CONSTITUTIONAL PROVISION HERE INVOLVED

ART. 1, SEC. 8. The Congress shall have power . . . To promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries.

STATUTES HERE INVOLVED

Title 35 U.S. Code, § 102. Conditions for patentability; novelty and loss of right to patent

A person shall be entitled to a patent unless—

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States, or

(c) he has abandoned the invention, or

(d) the invention was first patented or caused to be patented by the applicant or his legal representatives or assigns in a foreign country prior to the date of the application for patent in this country on an application filed more than twelve months before the filing of the application in the United States, or

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or

(f) he did not himself invent the subject matter sought to be patented, or

(g) before the applicant's invention thereof the invention was made in this country by another who had not abandoned, suppressed, or concealed it. In determining priority of invention there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other.

Title 35 U.S. Code, § 103. Conditions for patentability; non-obvious subject matter

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Title 35 U.S. Code, § 112. Specification

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention. A claim may be written in independent or dependent form, and if in dependent form, it shall be construed to include all the limitations of the claim incorporated by reference into the dependent claim.

An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

Title 35 U.S. Code, § 135. Interferences

Whenever an application is made for a patent which, in the opinion of the Commissioner, would interfere with any pending application, or with any unexpired patent, he shall give notice thereof to the applicants, or applicant and patentee, as the case may be. The question of priority of invention shall be determined by a board of patent interferences (consisting of three examiners of interferences) whose decision, if adverse to the claim of an applicant, shall constitute the final refusal by the Patent Office of the claims involved, and the Commissioner may issue a patent to the applicant who is adjudged the prior inventor. A final judgment adverse to a patentee from which no appeal or other review has been or can be taken or had shall constitute cancellation of the claims involved from the patent, and notice thereof shall be endorsed on copies of the patent thereafter distributed by the Patent Office.

STATEMENT OF THE CASE

Petitioners, Eugene A. Wahl and Vibra Screw Feeders, Inc., brought this action on United States Letters Patent No. 3,173,583, for a "Bin Activator" (E. 1), i.e., apparatus for facilitating the flow from storage bins or hoppers of bulk powdered, granular, pulverized or other non-liquid particulate materials.

Discharge of such materials from the storage bin or hopper is by gravity through an outlet in the bottom of the bin. To make the discharging stream of material manageable, the discharge outlet must be many times smaller than the upper portion of the bin. As the material passes or "funnels" through a converging section to the outlet, it may compact or wedge causing a jam at or

near the discharge outlet. Also, on occasion, only some of the material will discharge from the converging section resulting in a "bridge" or "arch" of compacted material. This interrupts the flow of material and creates a potentially dangerous situation of a sudden release of a large volume of heavy material. (E. 1, Col. 1)

The prior art efforts at solving these problems included externally attached vibrating devices and pokers and vibrating baffles placed in the throat of the bin. (45a, 57a) These expedients worked where, because of the nature of the materials or the size of the bin, severe jamming was not a problem. However, such prior art efforts failed to solve the problems where the storage of large quantities of hard-to-handle materials, such as wet sand, is required. In such situations, typical bins may hold tons of materials (251-2a, 603-4a) and have head-loads extending 10 to 50 feet above the discharge outlet of the bin. (E. 1, Col. 1)

Other prior unsuccessful attempts at solving the problems included rotating augers (230a) and large rotated wall scrapers (43a). One prior art consultant thought the solution to lie in configuration of the bin and designed bins having particular configurations, depending on the materials to be stored. (E. 13-17)

The solution of the patent consists of: first, the replacement of the conventional converging section of the hopper with a generally conical section mounted to be vigorously vibrated while it is performing the function of funnelling the stored material to the small discharge outlet and, second, the provision of material-agitating means consisting of a baffle which serves to "fluidize" the material and relieve the head-load over the discharge outlet. The baffle is positioned in and vibrates integrally with the generally conical funnelling section of the bin. The combined effect

of vibrating the specially shaped and located converging bin section in its entirety, together with the action of the baffle in it, solves the bin discharge problem recognized as being of major proportions by the material handling industry. (E. 1, 232-5a, 244-6a, 250-2a)

While the disclosure and claims of the patent in suit are directed to the apparatus which forms an integral part of a storage bin and which functions to promote the flow of materials from the storage bin, the District Court found the patent anticipated by conveyors or feeders used to carry the material away after the material has been dislodged from and is out of the storage bin—after the problem to which the patent is directed has ceased to exist. (App. B. 34-42)

Anticipation was pieced-out as follows:

The claims in suit designate the converging funnelling portion of the storage hopper as a "material-receiving member" which the District Court equated with that member of the conveyors or feeders which receives the material after it is discharged from the storage hopper. (App. B. 38-42, see E. 12, 26, 27)

The claims further require that the "material-receiving" portion of the storage hopper be "generally conical", a requirement which finds no response in the member which in the conveyors of feeders held to anticipate receive the material discharged from the storage hopper. (Cf. E. 1 and E. 12, 26, 27) A statement in the specification of the patent in suit that the bottom or material receiving portion of the patented storage hopper "may be of other shape" is given as the basis for holding that the material receiving member of the conveyor or feeder relied on is a "generally conical material-receiving mem-

ber" by application of the doctrine of equivalents. (App. B. 37-38)

The Court of Appeals treated the anticipation issue as turning on the resolution of a conflict in testimony. (App. A. 16-18) However, the basic error urged on appeal was one of law—the failure to judge novelty of the storage bin activator invention as it is defined by the claims of the patent in suit.

In its opinion the Court of Appeals noted Petitioner's insistence that "the shape and location of the material-receiving member is crucial to the invention", conceded that "plaintiff's argument on this score (novelty) is not without plausibility", but rejected that argument because "we assume it was made to the trial court and rejected" and concluded it was the function of the trial court to resolve the conflict in testimony "and we cannot hold that its resolution was clearly erroneous". (App. A. 18)

The District Court also found the patent in suit invalid for obviousness, without application of the requirements of Section 103 of the Patent Statutes or of this Court's decision in *Graham et al. v. John Deere Co.*, 383 U.S. 1 (1965).

Rather, the conclusion of obviousness was based on the District Court's finding of independent development by another. (App. B. 43-44) The Court of Appeals recognized a lack of plausibility in the finding but, nevertheless, accepted it and approved the holding. (App. A. 20-21)

Having broadened the claims beyond the subject matter of the patent to hold them anticipated and having overlooked the claims and the required determinations with respect to them on the issue of obviousness, the District

Court narrowed the claims for purposes of the infringement issue, thereby holding certain accused structures not to infringe. (App. B. 46-48)

The element of the claim which was narrowed relates to the position of the baffle or "material-agitating means" with respect to the generally conical converging portion of the storage bin. As issued by the Patent Office the claim requires the baffle to be within and secured to conical bin portion and "extending *substantially* to the said inlet opening thereof". The quoted portion as rewritten by the District Court is, "extending to *within one inch* of said inlet opening." There is no basis in the specification or file wrapper of the patent for the added limitation. (App. B. 48)

The narrowing of the claims for the infringement issue was sanctioned by the Court of Appeals on the same basis that the broadening of the same claims for purposes of anticipation was sanctioned—the existence of conflicting testimony as to claim language, the resolution of which was a function of the trial court. (App. A. 39-31)

REASONS FOR GRANTING THE WRIT

1. The decisions of the courts below conflict with the requirements of the patent statutes and decisions of this Court inasmuch as the District Court interpreted and the Court of Appeals approved the interpretation of claims one way for purposes of novelty and another for purposes of infringement.

In excess of 60,000 U.S. Letters Patent issue every year. They reflect virtually every aspect of technology and manufacture in our country. Each contains one or more claims allowed by the Patent Office and shaped with great care through prosecution proceedings between the inventor and the Patent Office to define the "metes and bounds" of the grant.

On numerous occasions this Court has pointed out that the patent claims are the measure of the invention. For example, in *Graver Tank & Mfg. Co., Inc.* v. *Linde Air Products Co.*, 1949, 336 U.S. 271 at 277, this Court stated as to patent claims that "their text must be sufficient to 'particularly point out and distinctly claim' an identifiable invention or discovery. We have frequently held that it is the claim which measures the grant to the patentee."

More recently, in *Graham et al.* v. *John Deere Co. of Kansas City et al.*, 1965, 383 U.S. 1, this Court has made clear that it is the invention defined by the patent claims which is to be judged for obviousness under Section 103 of the Patent Statutes as well as for utility and novelty under Sections 101 and 102. In the present case the claims were twice rewritten by the District Court. They were broadened beyond their terms and even beyond the scope of subject matter of the specifications on the issue of novelty. They were narrowed on the infringement issue

by the insertion of a limitation neither warranted nor required by the specification or the file wrapper of the patent in suit.

The patent in suit is entitled "Bin Activator" and the claims define the apparatus for curing compaction problems in storage bins. But the claims were broadened to read on feeders and conveyors which operate to receive and carry away the material after it is discharged from the storage bins—and, hence, after the problem to which the patent is directed has ceased to exist. The claims were made to read on the feeders or conveyors by reading out of the claims clear limitations including one which was inserted after rejection of broader claims by the Patent Office.

After reading limitations out of the claims when considering the novelty issue, the District Court on the infringement issue read into the claims a limitation which they did not contain and which was not required by either the specification of the patent or the prior art.

The Court of Appeals gave its approval both to the varying constructions given the claims and, impliedly at least, to the practice of giving one construction to the same claims on the validity issue and another for infringement.

Quite clearly, the situation revealed by the case at bar calls for the interposition of this Court. In its famous opinion in *White* v. *Dunbar,* 1886, 119 U.S. 47, this Court voiced its disapproval when the patentees asserted one construction for their claims to establish validity and another to establish infringement, stating (pp. 51-52):

> "Some persons seem to suppose that a claim in a patent is like a nose of wax which may be turned and twisted in any direction, by merely referring

to the specification, so as to make it include something more than, or something different from, what its words express. The context may, undoubtedly, be resorted to, and often is resorted to, for the purpose of better understanding the meaning of the claim; but not for the purpose of changing it, and making it different from what it is. The claim is a statutory requirement, prescribed for the very purpose of making the patentee define precisely what his invention is; and it is unjust to the public, as well as an evasion of the law, to construe it in a manner different from the plain import of its terms."

While the foregoing has application to patentees and patent owners, it is respectfully submitted that it is of equal importance that a patent claim not be treated as a "nose of wax" by an infringer or the Courts.

The public has an interest that the patent grant be restricted to its terms. This negative aspect of the patent grant—as an exception to the general rule against monopolies—has had frequent statement in the opinions of this Court and of the lower courts. The other aspect has not had equal stress. The public has an interest in the disclosure by the inventors of their inventions and discoveries. This interest is stated in the Constitutional grant of power on which the patent statutes are based—"To promote the progress of science and useful arts" (Article 1, Sec. 8). The over emphasis of the "anti-monopoly" philosophy cannot be discounted as a possible influence, when, as in the present case, the same claim of a patent is given one construction which invalidates it and a second and different construction to hold the claim not infringed. Each of the 60,000 or more who receive patent grants each year have paid the price which the law demands of them—the disclosure of their inventions and discoveries. Having paid the price and obtained from the Patent Office claims measuring the

extent of their respective grants, they are entitled to have such claims interpreted equally on both issues of validity and infringement.

2. The decisions of the Courts below are in conflict with the decisions of this Court as to the manner of determining obviousness under Section 103 and, additionally, add a new test of obviousness not stated in that section and in apparent conflict with other sections of the Patent Act.

This Court in its opinion in *Graham et al.*, v. *John Deere Company of Kansas City, et al.*, 1965, 383 U.S. 1, speaking of Section 103, stated that "The section is cast in relatively unambiguous terms" (p. 14) and that (p. 17):

> ". . . Under §103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined." . . .

The District Court did not make note of the differences between the patent claims and the prior art and then determine the obviousness of the advance made by the patentee.

The actual basis for the conclusion of obviousness drawn by the District Court was the finding that one Dumbaugh, an employee of Respondent, after the patented device of Petitioner was on the market and after it had been the subject of articles in five trade journals, arrived at the same solution independently.

The Court of Appeals although noting that Petitioner "with some plausibility, attached the testimony of this witness (Dumbaugh) as incredible.", accepted the finding and gave its approval to basing a holding of obviousness on evidence of independent development.

Congress has not designated independent development as an indicia of obviousness or as a bar to the issuance of a valid patent. To the contrary, Congress has recognized that substantially the same invention could occur to more than one person at about the same time, has provided that the prior inventor's activity is a bar to the issuance of a patent to the second inventor, (35 U.S.C. 102g) and has further provided for interference proceedings to determine which of multiple inventors is first and thus entitled to the patent grant (35 U.S.C. 135).

This Court has not spoken as to the consideration to be given to independent development on the issue of obviousness. In an instance in which two or more independently find a solution promptly after a problem is presented to the art, this may be a factor. But where the problem existed for years, and two conceive the solution, Congress has directed that the first shall have a patent. The District Court erred in finding obviousness and not applying the tests laid down by this Court.

CONCLUSION

The case at bar illustrates the need for this Court's guidance on the important questions as to the function of patent claims and to the requirement of uniform interpretation on the issues of patentability and infringement. The Petition should be granted.

Respectfully submitted,

EDWARD A. HAIGHT
JOHN W. HOFELDT
Attorneys for Petitioners

Of Counsel:
HAIGHT, HOFELDT & DAVIS
141 West Jackson Boulevard
Chicago, Illinois 60604

APPENDIX A

IN THE
UNITED STATES COURT OF APPEALS
For the Seventh Circuit
Chicago, Illinois 60604

Tuesday, November 2, 1971

Before

Hon. THOMAS E. FAIRCHILD, *Circuit Judge*
Hon. J. EARL MAJOR, *Senior Circuit Judge*
Hon. WILBUR F. PELL, JR., *Circuit Judge*

No. 18324
EUGENE A. WAHL and VIBRA SCREW FEEDERS, INC.,
Plaintiffs-Appellants,
vs.
CARRIER MANUFACTURING CO., INC.,
Defendant-Appellee.

Appeal from the United States Court for the Southern District of Indiana, New Albany Division.

IT IS ORDERED by the Court that the petition for rehearing filed in the above-entitled cause be, and the same is hereby denied.

IN THE

UNITED STATES COURT OF APPEALS

For the Seventh Circuit

SEPTEMBER TERM, 1970, APRIL SESSION, 1971

No. 18324

EUGENE A. WAHL and VIBRA SCREW FEEDERS, INC., *Plaintiffs-Appellants*,

v.

CARRIER MANUFACTURING CO., INC., *Defendant-Appellee*.

Appeal from the United States District Court for the Southern District of Indiana.

AUGUST 30, 1971

Before MAJOR, *Senior Circuit Judge*, and FAIRCHILD and PELL, *Circuit Judges*.

MAJOR, *Senior Circuit Judge*. This is an appeal from a judgment entered November 13, 1969, by Judge William E. Steckler, holding all four claims of United States Patent No. 3,173,583; entitled "Bin Activator," invalid, and dismissing plaintiffs' charge of infringement. Eugene A. Wahl (Wahl) is the owner of the patent and Vibra Screw Feeders, Inc. (Vibra Screw) is his exclusive licensee. The latter is a New Jersey corporation, and defendant Carrier Manufacturing Co., Inc. (now by change of name, Carman Industries, Inc.) is a Kentucky corporation having its principal place of business at Jeffersonville, Indiana.

After disposal of numerous discovery proceedings, the case came on for trial before the court without a jury on

November 6, 1967, and continued on November 7, 8, 9, 10, 11, 13 and 14. On the last date and at the conclusion of defendant's presentation, the case, on plaintiffs' request, was continued to August 19, 1968, on which date plaintiffs introduced testimony purportedly for the purpose of rebutting the case made by defendant. As might be expected after a trial of such length, the record is voluminous. (The transcript covers some 1300 pages, and the appendix filed in this court more than 600 pages.) In addition, many physical exhibits were introduced, including the patent in suit, numerous prior art patents and many drawings, diagrams, pictures, etc., all explained by expert witnesses as an aid to the court in its evaluation of the contentions advanced by the parties.

The prior art relied upon by defendant to anticipate and invalidate the patent in suit was (1) the Heavy Duty Feeder made and sold by plaintiffs for several years prior to the Wahl application filing date; (2) the Vibra-Portioner[1] which was at one time made and sold by defendant, and (3) the Musschoot Patent No. 3,083,811. The court found that the patent in suit was anticipated by each of these prior art citations, none of which was cited in the Patent Office and all of which were found to be more pertinent than that which was cited.

The court also found that the subject matter sought to be patented by Wahl, in view of the prior art, would have been obvious at the time the invention was made, to a person having ordinary skill in the art to which the subject matter pertains, and was, therefore, invalid under Title 35 U.S.C.A. Sec. 103.

---

[1] Carrier Patent No. 3,187,884 describes the Vibra-Portioner and may be considered as the same item of prior art.

The court in its findings 6, 7 and 8 describes the nature of the Wahl invention and sets forth the claims involved. Inasmuch as there is no dispute as to the propriety of these findings, we adopt them:

> "6. The specification of the Wahl patent in suit generally describes the apparatus set forth therein as follows:
>
> > 'This invention relates to apparatus for use in conjunction with a storage bin, or hopper, and more particularly to activator apparatus adapted for attachment to a storage bin to promote the flow of material therefrom.' (PXX-1, Col. 1, lines 6-10).

Also it is stated:

> 'An object of this invention is the provision of improved apparatus for use with a storage bin, or hopper, to promote a positive discharge of the contained material through the hopper discharge opening.' (PX-1, Col. 1, lines 43 to 46).

In the patent it is also stated:

> 'An object of this invention is the provision of apparatus for promoting the flow of material from a storage hopper having a discharge opening at the lower end thereof, which apparatus comprises a material-receiving member having sloping walls terminating in a material-dispensing opening, means vibratorily suspending the material-receiving member in alignment with the hopper discharge opening, means for vibrating the material-receiving member in a plane predominantly normal to the axis thereof, and means for imparting

such vibrations to the contained material in the region of the hopper discharge opening.' (PX-1, Col. 1, lines 54 to 65).

"7. The Court finds that the application for the Wahl patent in suit was filed on May 9, 1962, and is a continuation-in-part of an earlier application filed April 4, 1962 which was abandoned. The original application contained only sheet 1 of the patent drawings, and, in general, the specification was directed to the structure shown in Figure 1 of the drawings. The continuation-in-part application added sheet 2 of the drawings, and added to the specification a description of the device shown in Figure 4 of the drawings. The structure shown generally in the Wahl patent comprises a supply hopper terminating in an opening at the bottom thereof and, attached by resilient supporting means to the hopper, there is a cross member which carries a motor or vibrating member to vibrate this cross member. Attached to the cross member is a material-receiving means which is vibrated with the cross member and which material-receiving means is positioned below the supply hopper. In both forms of the bin activator of the Wahl patent, that of Figure 1 and Figure 4, there is included as attached to the material-receiving means, a material-agitating means which is vibrated with the material-receiving means. In Figure 1, the material-agitating means comprises upstanding rods entering into the supply hopper, and these upstanding rods are attached to the material-receiving means and vibrated therewith. In Figure 4, there is a different form of material-agitating means which comprises an upstanding rod secured to a bracket which is carried by the

material-receiving means, and this upstanding rod adjustably supports a baffle which is positioned within the material-agitating means and at the outlet opening of the hopper. As stated in the specification, the material-receiving means supporting the material-agitating means by being resiliently supported from the hopper is vibrated by a motor, and upon vibration of the material-receiving means and the material-agitating means, the bulk material in the hopper is induced to flow therefrom.

"8. Plaintiff charges infringement of claims 1, 2, 3, and 4 of the patent in suit. Claims 2, 3 and 4 are dependent from claim 1. Claim 1 is as follows:

'1. Apparatus for promoting the flow of material from a vertically-disposed storage bin having a discharge opening at the bottom, which apparatus comprises,

(a) a generally-conical, material-receiving member having an inlet opening corresponding substantially to that of the bin discharge opening and a truncated apex forming an outlet opening,

(b) means vibrationally supporting the conical member in a vertical position with the wall portion forming the inlet opening spaced from the bin wall,

(c) material-agitating means spaced from the inner wall of the conical member and rigidly secured thereto, said agitating means being disposed within said conical member and extending substantially to the said inlet opening thereof, and

(d) means vigorously vibrating the conical member.'

"Claim 2 calls for the invention of claim 1, but further defines the means for vibrating the conical member as a gyrator comprising an eccentrically-mounted weight rotatable by an electric motor. Claim 3 calls for the invention of claim 2, but defines the material-agitating means as a baffle member disposed in the region of the bin discharge opening. Claim 4 calls for the invention as recited in claim 2, and defines the material-agitating means as an inverted conical baffle member disposed in the region of the bin discharge opening, and further describes the vibration as in a plane normal to the axis of the conical member."

Plaintiffs on brief state the contested issues as follows:

"I. Was it reversible error for the District Court to adopt the overly simplistic definition of the Wahl invention urged by defendant on the validity issue, and then predicate its finding of anticipation (by three separate items of prior art) and obviousness on that definition rather than on a fair reading of the Wahl claims in context?

"II. Was it reversible error for the District Court to adopt the unduly limited definition of the Wahl invention urged by defendant on the infringement issue, involving dimensional limitations nowhere mentioned in the Wahl patent, and then predicate its finding of non-infringement (as to some but not all of defendant's devices) on that definition rather than on a fair reading of the Wahl claims in context?"

It appears to us that issue I is stated in a rather novel manner. However stated, we think the ultimate issue is whether the court's findings of fact are clearly erroneous.

Rule 52 (a) of the Federal Rules of Civil Procedure provides in part:

> "Findings of Fact shall not be set aside unless clearly erroneous, and due regard shall be given to the opportunity of the trial court to judge of the credibility of the witnesses."

The two principal witnesses were Wahl, the patentee, who testified at length in explaining his patent and his invention, or what he thought he had invented, and Don A. Fischer, an expert witness for defendant. We think it fair to state that a reading of the testimony of these two witnesses reveals that Wahl had much practical experience in the manufacture and development of apparatus designed to facilitate the withdrawal of material from storage bins. It is conceded, however, that he was not an expert in reading and describing patent claims. On the other hand, Fischer lacked the practical experience of Wahl but was eminently qualified to interpret patent claims and the disclosure in connection therewith. He was an engineer, a former Dean of an engineering school, and a practicing attorney for six years, admitted to practice before the Patent Office. While the district court did not expressly so state, it is evident that in the main it rejected the testimony of Wahl and credited that of Fischer.

Plaintiffs, consistent with the nature of their presentation here, rely upon the testimony of Wahl and ignore that of Fischer; in fact, on brief they do not mention Fischer's name or refer to his testimony except on a point relative to the issue of infringement.

Plaintiffs in their reply brief state that the district court did not "understand the concept of Wahl's claimed invention and how it differs from the prior art," and that

he was "deceived * * * aided and abetted by a Professor Fischer, whose professorial charisma was relied on by defendant to legitimatize defendant's courtroom ploy."[2]

The record refutes the suggestion that Judge Steckler was led astray. It reveals that he was keenly aware of the issues for decision and the contentions of the respective parties, and actively participated in the examination of the expert witnesses. He required each side to submit proposed findings and conclusions of law, upon which arguments were heard. At the conclusion of such arguments counsel for both sides were invited to the court's chambers for a discussion concerning the findings and conclusions of law proposed by defendant. The court required of defendant numerous changes in its proposal, as evidenced by the court's entry of August 6, 1969, "Court met with counsel in chambers concerning the finalization of findings of fact and conclusions of law and indicated to counsel its objections to the proposed findings of fact and conclusions of law tendered by defendant and made suggestions for amendments thereof. Counsel for defendant is to prepare for submission to Court amended proposed findings of fact and conclusions of law and is to provide a copy to plaintiffs before filing the same with the Court." Defendant's proposal, amended to meet the requirements of the court, was adopted on November 5, 1969.

We hardly need cite cases in support of the rule that findings of fact of the trial court should not be set aside

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[2] In a footnote they state that Fischer has given "expert testimony in patent cases about 45 times. It is apparent that no one is an expert in 45 different subjects." On the other hand, it is our thought that he must have proven his competency as an expert; otherwise, he would not have been so often called upon.

on review unless they are clearly erroneous. One case, however, *Wahl* v. *Carrier Mfg. Co., Inc.*, 358 F.2d 1, a decision of this court, is of particular pertinency. In that case the action was brought by Wahl against Carrier for infringement of a "Power-Feeding Apparatus." The trial court found the patent valid and infringed, and its findings were based largely on plaintiffs' expert testimony. The parties were the same as those here, the attorneys on both sides were the same, and the case was tried by the same trial judge. In affirming the judgment, we stated (page 3):

> "We agree with plaintiffs that like many patent infringement actions this one turns on ultimate technical facts the determination of which requires resolutioin of conflicts in the testimony of experts, and that the court's recognition of the difficulties inherent in arriving at findings in this technical area did not remove those findings, when made, from the scope of Rule 52 (a).
>
> "Therefore, insofar as the detailed findings of the court, upon which it predicates its conclusions of validity and infringement, concern factual issues such as the use made of prior art, the nature of the improvement made over prior art, and the characteristics and operational functions of the patented structure and the accused apparatus, Rule 52 (a) of the Federal Rules of Civil Procedure (28 U.S.C.A.) applies. The court heard the testimony of expert witnesses in connection with these matters and witnessed the demonstration of the physical exhibits, including the operation of the accused apparatus. The scope of our review of such findings is therefore limited to a determination of whether or not they are 'clearly erroneous'. Armour

& Co. v. Wilson & Co., 7 Cir., 274 F.2d 143, 151-157; Minnesota Mining and Mfg. Co. v. Technical Tape Corp., 7 Cir., 309 F.2d 55, 57; Aerosol Research Company v. Scovill Manufacturing Co., 7 Cir., 334 F.2d 751, 753. If they find support in the evidence we are bound thereby and there remains but the question of whether the court applied the correct legal criteria in reaching the ultimate conclusions it did."

Plaintiffs attempt to escape the potency of Rule 52 (a) by arguing that we are in as good position to pass upon the validity of the patent in suit as was the district court. That argument is reiterated in the reply brief, "A reading of the District Court's Findings and Conclusions, the patent in suit and the three prior references held to be anticipations will provide this Court with all the essential facts it needs to review the District Court's holding of invalidity."[3]

Cited in support of this argument are two decisions of this court, *Charles Peckat Mfg. Co. et al.* v. *Jacobs*, 178 F.2d 794, and *Nasco Incorporated* v. *Vision-Wrap, Inc.*, 352 F.2d 905. The situation in those cases was a far cry from that here. In *Peckat*, there was no parol testimony upon the issue of anticipation by the prior art, and we held that we were in as good position to interpret the patent and those relied upon to anticipate as was the trial court. In *Nasco*, we had a similar situation and stated (page 908):

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[3] Plaintiffs attached to their reply brief a chart submitted, so it is asserted, to clarify plaintiffs' argument to this court. It supposedly illustrates the Wahl device, defendant's competing device, and the prior art devices. There is no showing as to who prepared the chart, or when, but admittedly it was not an exhibit in the district court.

"The defendant offered no testimony, expert or otherwise, on the prior patent art. The appealed decision rests entirely on documentary evidence and physical exhibits. Consequently, the court's findings, in so far as they concern the use made of prior art, the nature of the improvement made over prior art, and the operational functions and characteristics of the patented structure and the accused device, are deprived of the degree of finality which would otherwise attach under Rule 52 (a) of the Federal Rules of Civil Procedure (28 U.S.C.A.). We are in as good a position as the trial court to examine and evaluate the evidence and make the necessary determinations ourselves."

In marked contrast, the court in the instant case heard voluminous testimony in a trial which lasted eight days. Both Wahl and Fischer in their capacity as experts testified in great detail in explanation of the many physical exhibits, including the patent in suit, the prior art cited in the Patent Office, and that not cited but relied upon by defendant and held by the court to anticipate.[1]

Plaintiffs' contention that the trial court did not understand the Wahl invention and, therefore, erroneously found that it was anticipated by prior art disclosures is predicated mainly on the testimony of Wahl, ignoring that of Fischer, defendant's expert witness. It would prolong this opinion beyond any permissible length to set forth all of the court's findings on this phase of the case; therefore, we shall quote only the finding with reference to the

[1] The transcript contains some 1294 pages of which 582 pages are devoted to the testimony of Wahl, and 270 pages to that of Fischer. Thus, about two-thirds of the transcript is devoted to the testimony of these two witnesses.

Heavy Duty Feeder made and sold by Plaintiffs. The court found:

"10. The facts concerning the Wahl heavy duty feeder:

"(a) It is conceded that Vibra Screw sold a heavy duty feeder more than one year prior to the filing of the original application for the Wahl patent. This heavy duty feeder is shown in defendant's Exhibits AA-1, B, C, D and E. As stated in defendant's Exhibit A-1, one of the purposes of the vibrating portion of the heavy duty feeder is to provide a vibrating baffle plate attached to a feeder trough which constitutes a material-receiving member, and the vibrating baffle plate enters the supply bin to transmit vibration directly into the material, facilitating the flow of material from the supply bin into the feeder. Although this device included a feeder for the volumetric discharge of material from a supply hopper, essentially there is shown in the heavy duty feeder, a material-receiving member positioned below a supply hopper, a vibrated material-receiving member which carries a vibrated material-agitating means positioned within the material-receiving member, and which material-agitating means is positioned adjacent the discharge outlet of a hopper, and upon vibration induces the flow of material therefrom. In function and in structure, the vibrating portions of the heavy duty feeder are substantially identical with the structure shown in Figure 4 of the Wahl patent in suit.

"(b) During the course of the trial, Mr. Wahl, plaintiff and owner of the patent here in suit,

referred to a difference between the heavy duty feeder and the bin activator shown in his patent, stating that the heavy duty feeder was intended only for use with small bins or hoppers, whereas, his bin activator was intended for use primarily with large hoppers. The Court finds that the specification of the Wahl patent and the claims do not state that the bin activator is intended for use primarily with large hoppers. Wahn conceded that the bin activator of the patent in suit could be applied to very small bins, and that under these circumstances, either the bin activator or heavy duty feeder could be used to induce the flow of material from the bin. Furthermore, the literature issued by Vibra Screw (Exhibit D) relating to the heavy duty feeder states: 'Designed for tonnage rates, it connects to any supply pipe or hopper and will consist flow of material out of such hoppers.'

"(c) The Court finds that the Wahl heavy duty feeder contains the elements of the claims of the patent in suit. Although element (a) is in the claim defined as a generally conical material-receiving member, the specification of the patent, in Col. 5, states that this material-receiving member may be conical, square, rectangular, or any other shape to conform to a particular hopper shape. The material-receiving member of the heavy duty feeder is therefore the equivalent of the generally conical material-receiving member called for in claim 1.

"(d) The Court finds that the claims of the patent in suit may be read on the structure of the

heavy duty feeder, and that none of the prior art cited by the Patent Office is as pertinent to the invention claimed in the Wahl patent as the Wahl heavy duty feeder. If the Patent Office, during the prosecution of the application for the Wahl patent, had before it the drawing of the heavy duty feeder (Exhibit B), with the knowledge that the device was on sale in 1959, the Patent Office would not, in the opinion of the Court, have granted any claims in the Wahl application.

"(e) The file history of the application for the patent in suit discloses that the existence of the heavy duty feeder was not called to the attention of the Patent Office."

It will be noted that paragraphs (a) and (b) of this finding are based largely upon concessions made by Wahl during his cross-examination, while paragraphs (c), (d) and (e) are based on the testimony of Fischer.

Fischer testified that the claims of the patent read directly on the Vibra Screw Heavy Duty Feeder as illustrated by Exhibit B, and that all of the elements function in the same way to produce the same result as the device of the patent in suit. He pointed out that during the prosecution of the application for the Wahl patent there was no disclosure to the Patent Office by Wahl of the existence of the Vibra Screw Heavy Duty Feeder and the fact that it had been on sale by plaintiffs more than one year prior to the filing of the application for the Wahl patent. He also testified that none of the prior art cited by the Patent Office was as pertinent to the invention claimed in the Wahl application as the device illustrated in Exhibit

B, and that in his opinion if the Patent Office had before it the drawing of Exhibit B with the statement that the device was on sale in 1950, the Patent Office would not have granted the claims of the Wahl patent.

Thus, the trial court was confronted with the testimony of two knowledgeable witnesses who in some respects were in wide disagreement as to what Wahl had invented, as disclosed by his patent, and the disclosure of the prior art. It was that court's function, not ours on review, to weigh the conflicting testimony and judge of the credit to be given the witnesses. We are satisfied that the court properly performed its duty in this respect. Certainly we cannot hold that the finding was clearly erroneous under Rule 52 (a).

The court found that Wahl's patent was anticipated by the Vibra-portioner manufactured and sold by defendant, and by Carrier Patent No. 3,187,884, issued to defendant. While the court made a separate finding as to each of these items, the patent discloses and illustrates the Vibra-Portioner and, as stated in plaintiffs' brief, "* * these items of prior art are properly treated as one item." Plaintiffs' principal point is that the material-receiving means of the Wahl invention were not disclosed by these items of prior art. Plaintiffs state on brief, "As stated several times herein, the shape and location of the material-receiving member is crucial to the invention."

On this phase of the case, as well as on many others, the testimony of the experts as to what was shown by Wahl and the prior art under discussion was conflicting. For instance, Wahl testified:

> "A. The Carrier Patent does not have a material-receiving member coincident with the compaction zone

which in this case, as in all other conical members, lies toward the outlet of the conical member.

Q. [By Mr. Brown] Can you tell us where that is in relation to the reference numerals?

A. That would be just above numeral 32—let us say we are now talking about the hopper designated by number 31, the outlet of the hopper I believe is number 32 and the compaction zone lies just above the . . .

Q. Mr. Wahl, what measures do you find Carrier Patent teaches in connection with relieving problems of flow at that particular zone?

A. The only thing Carrier uses there is a vibrating baffle similar to that which appears in the Wahl Heavy Duty Feeder."

On the other hand, Fischer testified:

"Q. Are you able, then, in your interpretation of claim 1 of the Wahl patent in suit, to find in the Carrier patent, all of the elements of the claim?

A. Yes, I did.

Q. Do those elements, as set forth in the Carrier patent, operate in substantially the same manner to produce substantially the same result as the bin activator of the Wahl patent?

A. Yes, they do. The material-agitating means vibrates the material and it flows out of the top receptacle into the material-receiving member that also vibrates the material, and the material comes out of chutes from the material-receiving member."

He also testified that in his opinion if the Patent Office had had before it prior art such as the Carrier patent, it would not have granted the claims of the Wahl patent.

The court found that Wahl's invention was anticipated by Musschoot Patent No. 3,083,811, issued April 2, 1963. Plaintiffs argue that like all other items of prior art found by the district court to anticipate, there is not found in Musschoot a "general-conical material-receiving member," as disclosed by Wahl. Plaintiffs' argument as to Musschoot, as it is to all other prior art found to anticipate, relies upon the testimony of Wahl and ignores that of Fischer. The latter testified in detail in comparing Musschoot with Wahl as the basis for his conclusion that all of the elements set forth in the Wahl patent were found in the disclosure of Musschoot, and that the structure shown performed the same function as the Bin Activator in Wahl.

To hold, as plaintiffs would have us do, that the court's findings that Wahl's Heavy Duty Feeder, defendant's Vibra-Portioner (Carrier patent No. 3,187,884), and the Musschoot patent did not anticipate Wahl would require us to conclude that the trial judge improperly gave credit and weight to the testimony of Fischer. We recognize that plaintiffs' argument on this score is not without plausibility, but we assume it was made to the trial court and rejected. It was the function of that court to resolve the conflict in the testimony, and we cannot hold that its resolution was clearly erroneous.

Title 35 U.S.C.A. Sec. 103 provides that a patent may not be obtained "if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains."

The court (finding 15) found:

> "The differences between the subject matter sought to be patented in the Wahl patent and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains."

The court in paragraph (b) of finding 15 found:

> "The Court finds from the record in this case, and the prior art devices referred to above, that at the time the Wahl asserted invention was made the art of vibration to induce material to flow from a hopper was well known. The level of the skill at that time was such that it was known, or obvious, to a person of ordinary skill in the art to induce flow from a hopper by the use of a vibrating material-receiving means which carries a vibrating agitating means positioned within a hopper adjacent to the outlet end of a hopper or just below the discharge end of a hopper, whereby the simultaneous vibration of the material-agitating means and material-receiving means would induce flow of hard-to-handle material from the hopper, thus preventing the bridging or arching of material within the hopper. The witness Dumbaugh, an employee and officer of defendant corporation, testified that he was first employed by defendant on August 1, 1962 when the corporation had few employees, and that his prior experience did not include any information relative to bin activators, feeders or other vibrating devices. Upon becoming employed by defendant, his initial project was to improve the Vibra-Portioner, then being sold by defendant, and with-

out any experience in the vibrator field, and within a matter of 6 weeks, he had developed a device substantially identical with that shown in the Wahl patent, functioning in the same way to produce the same result. The Court finds from this evidence it is established that to a person of less than ordinary skill in the art, the device shown and described in the Wahl patent, functioning in the same way to produce the same result, could be developed within a relatively short period of time from the time the problem was first encountered."

The court also found (finding 16):

"There is an assertion that defendant's accused vibrating hoppers were copied from plaintiffs' commercial device, and the Court finds as a fact, that Dumbaugh, an employee of defendant corporation, completed the design of the prototype, which ultimately became defendant's feeders, as early as September 16, 1962, when he modified the Vibra-Portioner then being sold by defendant. Prior to this time he had not seen any of the literature issued by plaintiff. Some reference has been made to the proposed sale by plaintiff of a feeder to the Austin Company, but the Court finds, as a fact, that the first contact defendant had with the Austin Company job was November 9, 1962, after defendant had completed its modified version of its Vibra-Portioner. The hoppers made by defendant herein charged to infringe were developed independently by defendant."

There is no question but that Dumbaugh testified as the court found. Plaintiffs, with some plausibility, attack the testimony of this witness as incredible. Again, however,

credibility of the witness and the weight to be given his testimony was a matter for the trier of the facts.

In *Graham et al.* v. *John Deere Co., et al.*, 383 U.S. 1, the court in discussing the factors relevant to the issue of obviousness stated (page 17):

> "Under Sec. 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented. As indicia of obviousness of nonobviousness, these inquiries may have relevancy."

See also our decision in *Akron Brass Co. v. Elkhart Brass Mfg. Co.*, 353 F.2d 704, 706.

The court was not unmindful of plaintiffs' reliance upon commercial success, as shown in its conclusion of law:

> "Although plaintiffs have established some commercial success of the devices covered by the patent in suit, such commercial success cannot in a case such as this, render valid a patent otherwise invalid. In any event, commercial success may be used only where there is some doubt as to the validity of a patent. Good and valid patents do not need commercial success to sustain them. Invalid patents cannot be helped by commercial success."

In connection with Dumbaugh's solution of the problem of discharging materials from an upper bin, the statement of this court in *Novo Industrial Corp.* v. *Standard Screw Co.*, 374 F.2d 824, 828, is pertinent:

> "The development of the valve of the patent in suit, and the independent and almost contemporaneous development and introduction of the defendant's accused valve structure which followed, in our judgment warrant the conclusion that the structure of the patent in suit was but the result of application of ordinary skill in the art to a problem which for the first time was beginning to assume significant commercial importance to the automotive industry."

The court's finding on the issue of obviousness also finds support in the testimony of defendant's expert, Fischer, who as a university professor of engineering for some three years, frequently submitted problems to the students for solution as a part of their training program. After relating his experience with his students, particularly those who had about completed their engineering course, he concluded his testimony as follows:

> "Q. Then my question is would the solution to the problem as proposed by Wahl in his patent have been obvious to a person having ordinary skill in the art?
>
> A. In my opinion it certainly would. And I also base this on what it states in the Musschoot patent about arching and how to break up arching."

We find no reason to reject the court's finding on the issue of obviousness, and it follows that it correctly held as a matter of law that the Wahl patent was invalid for that reason.

We now consider Carrier Reissue Patent No. 26,291, issued October 31, 1967, with claims 7, 8, 9 and 10, which thereby became additional to those originally in Carrier Patent No. 3,187,884. The court in finding 17 relative to ths reissue patent preliminarily stated that it "plays a very important role in the consideration of this case." We disagree with this statement and think its role is minor, in fact, of little if any consequence. On October 14, 1969, on defendant's application, the Patent Office allowed a disclaimer of all claims of the reissue patent, thereby effectively removing them from the case. See *Soundscriber Corp. v. United States*, 360 F.2d 954, 961 (U.S. Court of Claims); *In Application of Heinle*, 342 F.2d 1001, 1006 (U.S. Court of Customs and Patent Appeals). This disclaimer was allowed about a month prior to the entry of the judgment in this case and we are not advised if the court was aware of the disclaimer.

Counsel for defendant late in the trial did suggest "that these claims granted in the reissue patent are probably invalid because of the information we discovered from Mr. Wahl concerning his own bin feeder. * * * But what this does is to tie the earlier Carrier Patent, the earlier Exhibit B bin activator—or heavy duty feeder of Mr. Wahl, the subject matter of the Wahl Patent, all in the same category with the Carrier Patent and its disclosure preceding that which is shown in the Wahl Patent. * * * The Patent Office, as it has now done, could have granted that claim to Carrier. Carrier would then have the patent, Wahl would not; Carrier would be suing Wahl for infringement."

We strongly suspect that it was the strategy of defendant's counsel to inject these reissue claims into the case in an attempt to obtain a finding that the Carrier patent

was valid or at least an expression by the court to that effect. This latter, as subsequently shown, it succeeded in doing. No issue as to the validity of Carrier was before the court, and we think it was error to make a finding or express an opinion on that score.

Defendant on brief explains the reason for its disclaimer of the reissue claims, as follows, "It has been concluded that since Wahl made and sold these heavy duty feeders in 1959 and 1960, these heavy duty feeders stand as a prior use bar to the valid grant to defendant of the claims added by reissue. *In effect, insofar as the material-agitating means of plaintiff's heavy duty feeder are concerned, they are substantially equated with the same elements in the Carrier patent.* [Italics supplied.] For this reason, the claims added to the Carrier patent by reissue have now been disclaimed and the action is completely consistent with the position of defendant in this case to the effect that not only is the structure of the Carrier patent a complete anticipation of the claims of Wahl's bin activator, but also plaintiffs' heavy duty feeder is likewise a complete anticipation."

This explanation engenders more confusion than light. The court had previously found (finding 10 (c)) "that the Wahl heavy duty feeder contains the elements of the claims of the patent in suit," and for that reason anticipated. The court had also previously found (finding 11 (d)), referring to the material-receiving means of Carrier, "* * * the structure and the function of this portion of the device is substantially identical to the structure and function of the device shown in Figure 4 of the Wahl patent in suit." In finding 11 (e) the court had found "that the device of the Carrier patent has all of the elements of claim 1, with these elements functioning substan-

tially in the same way to produce substantially the same result in the same way as the device of the patent in suit."

Thus, defendant's explanation leads to the conclusion that while Carrier disclosed all of the elements of Wahl and the latter was anticipated by its Heavy Duty Feeder, Carrier was left unscathed by the same prior art. Admittedly, Wahl's Heavy Duty Feeder was prior art to Carrier, as it was to Wahl.

The court also previously found (finding 13) that the Musschoot patent contained all of the basic elements of the claims in Wahl and "these elements in the Musschoot device function in the same way as the bin activator in the Wahl patent to produce substantially the same results." Musschoot was prior art to Carrier, as it was to Wahl.

As stated by defendant's counsel before the trial court, the original Carrier patent and Wahl's Heavy Duty Feeder (the subject matter of the Wahl patent) fall in the same category.

The court in its finding relative to the reissue claims made no mention of the fact that they had been disclaimed on the basis of the disclosure made in Wahl's Heavy Duty Feeder and were no longer in the case.

Paragraph (a) describes the procedure followed by Carrier in obtaining the reissue claims. Paragraph (b) points out that both the Carrier and Wahl patents were pending in the Patent Office at the same time and that no interference was declared. Paragraph (c) states:

> "(c) Based upon the record in this case it is the Court's opinion that, if the Patent Office had declared an interference between the application for the Car-

> rier patent and the application for the patent in suit, Carrier should have been determined to be the prior inventor, and the claims directed to the common subject matter,—i.e., the concept of providing a material-receiving means vibrationally supporting a material-agitating means positioned below a supply hopper—would have been awarded to Carrier, and no claims would have been awarded to Wahl."

In our view, this is not a finding of fact, but is argumentative in nature and based on speculation. We do not know what the Patent Office would have done if an interference had been declared, and we doubt if Judge Steckler or defendant's expert witness could have known. Either party could have called for an interference. If Carrier, whose application for patent was filed prior to that of Wahl, had thought that its disclosure duplicated Wahl, it seems reasonable to believe that it would have called for an interference. Its failure to do so raises an inference that it had no such notion at the time the two patents were pending, and that the theory now advanced was evolved in preparation for this lay suit.

Paragraph (d) states:

> "(d). The fact that the Patent Office granted the Carrier reissue patent with claims dominating the structure shown in the Wahl patent in suit is evidence that the Patent Office, with its expertise, considers that the subject matter disclosed in the original Carrier patent is substantially identical with the disclosures in the Wahl patent in suit."

Again, we think this finding is more argumentative than factual. If, however, the subject matter disclosed in Carrier was substantially identical with that in Wahl, it was

also substantially identical with the disclosure of Wahl's Heavy Duty Feeder found to anticipate Wahl and prior art to both Wahl and Carrier. While there may be some portions of the finding on this issue which are tenable, we think considered as a whole it is clearly erroneous for the reasons stated.

The court after finding the patent invalid proceeded to make findings concerning the alleged infringement of the claims, if valid, by various devices made and sold by defendant. Plaintiffs offered in evidence an exhibit which disclosed the drawings of defendant's alleged infringing devices. The court, for reasons subsequently shown, divided such devices into two categories and found some to infringe and others not.

Defendant in defense of the infringement charge relies upon the doctrine of file wrapper estoppel, a theory thoroughly embedded in the law. Among the numerous cases cited we need mention only *Exhibit Supply Co.* v. *Ace Patents Corp.*, 315 U.S. 126, and the recent decision of this court in *Taylor Reed Corp.* v. *Mennen Food Products, Inc.*, 324 F.2d 108. The theory is aptly stated by this court in *Taylor Reed* (page 113):

> "The applicant having limited his claim by amendment and accepted a patent, brings himself within the rule that if the claim to a combination be restricted to specified elements, all must be regarded as material, and that limitations imposed by the inventor, especially such as were introduced into an application after it had been persistently rejected, must be strictly construed against the inventor and looked upon as disclaimers."

There is no dispute as to the circumstances relied upon by defendant as constituting file wrapper estoppel. As the court found, the original claims filed by Wahl were rejected over the prior art for the reasons that there was no specific location for the material-agitating means with respect to the conical member. Specifically, the court found:

> "By a Patent Office rejection of January 28, 1964, the Examiner rejected this claim for the reason that the location of the agitating means was recited so broadly that it read upon one of the elements of the prior art Roise patent. After this rejection, this claim was amended to locate the agitating means as 'being disposed within said conical member and extending substantially to the said inlet opening thereof.' The Court finds that in order to avoid prior art, the agitating means was specifically located as being within the conical member and *extending substantially to the said inlet opening thereof.*" (Italics supplied.)

The court further found:

> "(e) The vibrating hoppers sold by both plaintiff and defendant have the material-agitating means located at varying positions with respect to the inlet opening. Sometimes the apex of the cone or baffle, which constitutes the material-agitating means, is positioned substantially below the inlet opening, and in other devices, this material-agitating means is positioned substantially below the inlet opening of the cone member or material-receiving means. In the light of the prosecution history, and the file wrapper estoppel just referred to, the Court finds there is infringement of these claims and if the apex of the cone or the material-agitating means comes *within one inch of the*

inlet opening. There are some such devices made and sold by defendant, and if the claims are valid, such devices infringe the claims of the patent in suit." (Italics supplied.)

The court concluded:

"Although an invalid patent may not be infringed, the Court finds that if the claims of the patent in suit are valid they are infringed only by each of the devices made and sold by defendant wherein the apex of the cone, or material-agitating means comes *within one inch of the inlet opening of the vibrating* material-receiving means, and this finding is based upon the file wrapper estoppel heretofore referred to." (Italics supplied.)

Thus, the issue in this facet of the case is whether the requirement that the agitating means be located as "extending substantially to the said inlet opening thereof" (the conical member), inserted in the claims in order to secure their allowance over the prior art, can reasonably be interpreted to be met only if such means "comes within one inch of the inlet opening," as interpreted and found by the court.

Plaintiffs argue that this dimensional limitation is arbitrary and devoid of all realism. They argue, as Wahl indicated in his testimony, that "extending substantially" to the inlet opening could as well be interpreted as meaning a location at any point in the upper half of the cone, as contrasted with the lower half.

The fallacy of plaintiffs' argument on this point is that it is without substantial support in the evidence. Only Wahl and Fischer testified as to the interpretation to be

given to the phrase, "within one inch of the inlet opening." Fischer reviewed the file wrapper history, including the circumstances under which Wahl's claims were allowed, a reading of which discloses that he had a substantial basis for his opinion that the dimensional limitation of one inch was proper.

On the other hand, Wahl's testimony as to his interpretation of the claims of his patent in the light of the prosecution history and what he considered to be an infringement, specifically with reference to the material-receiving means, was confusing and uncertain. He expressed the view that it could be at any point within six inches or one foot from the inlet opening. His confusion in this respect is shown by his testimony:

> "Q. Now, each time you have notified a customer that Carrier, in your opinion, is infringing the claims of the patent in suit, have you known specifically which device Carrier was proposing to sell to that customer?
>
> A. We didn't particularly concern ourselves about which device. So far as we are concerned, both devices are take-offs from our bin activator.
>
> Q. Do they come within the claims of the patent?
>
> A. We think they do.
>
> Q. Regardless of the position of the cone?
>
> A. That's right.
>
> Q. Even if the cone is adjacent to the base outlet of the vibrating member?
>
> A. Yes."

The court was required to interpret the phrase, "extending substantially to the said inlet opening." This must have presented a perplexing problem, but it is not discernible how the court could have made such determina-

tion except by utilizing the evidence before it. As stated, the only positive testimony was the opinion of Fischer, and we cannot hold that the court erred in basing its finding and conclusion thereon. It follows that defendant's devices wherein the apex of the cone comes within one inch of the inlet opening of the vibrating material-receiving means, infringe; otherwise, they do not.

Finally, plaintiffs argue that if the agitating means were lowered from one inch below the inlet to halfway down from the inlet, the combination would function in substantially the same way to obtain substantially the same result. This argument is based on the doctrine of equivalents, and, if accepted, would emasculate or negate the doctrine of file wrapper estoppel. We know of no authority, and doubt if there is any, which would support this argument.

The judgment of the district court adjudicating and decreeing the claims of the patent in suit invalid and dismissing plaintiff's complaint for infringement thereof is

AFFIRMED.

APPENDIX B

Findings of Fact and Conclusions of Law.

1. Plaintiff, Eugene A. Wahl, is the owner of United States Patent No. 3,173,583.

2. Plaintiff, Vibra Screw Feeders, Inc., a New Jersey corporation, is the exclusive licensee under United States Patent No. 3,173,583.

3. Defendant, Carrier Manufacturing Co., Inc. (now by change of name, Carman Industries, Inc.), is a Kentucky corporation having its principal place of business at Jeffersonville, Indiana.

4. This Court has jurisdiction of this cause of action because it arises under the Patent Statutes of the United States.

5. By the Complaint herein, defendant is charged with infringement of claims 1, 2, 3 and 4 of patent No. 3,173,583, and defendant alleges that the claims of the patent are invalid and that it has not infringed any of the claims of the patent.

6. The specification of the Wahl patent in suit generally describes the apparatus set forth therein as follows:

> "This invention relates to apparatus for use in conjunction with a storage bin, or hopper, and more particularly to activator apparatus adapted for attachment to a storage bin to promote the flow of material therefrom." (PX-1, Col. 1, lines 6-10).

Also, it is stated:

> "An object of this invention is the provision of improved apparatus for use with a storage bin, or hopper, to promote a positive discharge of the contained material through the hopper discharge opening." (PX-1, Col. 1, lines 43 to 46).

In the patent it is also stated:

> "An object to this invention is the provision of apparatus for promoting the flow of material from a storage hopper having a discharge opening at the lower end thereof, which apparatus comprises a material-receiving member having sloping walls terminating in a material-dispensing opening, means vibratorily suspending the material-receiving member in alignment with the hopper discharged opening, means for vibrating the material-receiving member in a plane predominantly normal to the axis thereof, and means for imparting such vibrations to the contained material in the region of the hopper discharge opening." (PX-1, Col. 1, lines 54 to 65).

7. The Court finds that the application for the Wahl patent in suit was filed on May 9, 1962, and is a continuation-in-part of an earlier application filed April 4, 1962 which was abandoned. The original application contained only sheet 1 of the patent drawings, and, in general, the specification was directed to the structure shown in Figure 1 of the drawings. The continuation-in-part application added sheet 2 of the drawings, and added to the specification a description of the device shown in Figure 4 of the drawings. The structure shown generally in the Wahl

patent comprises a supply hopper terminating in an opening at the bottom thereof and, attached by resilient supporting means to the hopper, there is a cross member which carries a motor or vibrating member to vibrate this cross member. Attached to the cross member is a material-receiving means which is vibrated with the cross member and which material-receiving means is positioned below the supply hopper. In both forms of the bin activator of the Wahl patent, that of Figure 1 and Figure 4, there is included as attached to the material-receiving means, a material-agitating means which is vibrated with the material-receiving means. In Figure 1, the material-agitating means comprises upstanding rods entering into the supply hopper, and these upstanding rods are attached to the material receiving means and vibrated therewith. In Figure 4, there is a different form of material-agitating means which comprises an upstanding rod secured to a bracket which is carried by the material-receiving means, and this upstanding rod adjustably supports a baffle which is positioned within the material-agitating means and at the outlet opening of the hopper. As stated in the specification, the material-receiving means supporting the material-agitating means being resiliently supported from the hopper is vibrated by a motor, and upon vibration of the material-receiving means and the material-agitating means, the bulk material in the hopper is induced to flow therefrom.

8. Plaintiff charges infringement of claims 1, 2, 3 and 4 of the patent in suit. Claims 2, 3 and 4 are dependent from claim 1. Claim 1 is as follows:

> "1. Apparatus for promoting the flow of material from a vertically-disposed storage bin having a discharge opening at the bottom, which apparatus comprises,

(a) a generally-conical, material-receiving member having an inlet opening corresponding substantially to that of the bin discharge opening and a truncated apex forming an outlet opening,

(b) means vibrationally supporting the conical member in a vertical position with the wall portion forming the inlet opening spaced from the bin wall,

(c) material-agitating means spaced from the inner wall of the conical member and rigidly secured thereto, said agitating means being disposed within said conical member and extending substantially to the said inlet opening thereof, and

(d) means vigorously vibrating the conical member."

Claim 2 calls for the invention of claim 1, but further defines the means for vibrating the conical member as a gyrator comprising an eccentrically-mounted weight rotatable by an electric motor. Claim 3 calls for the invention of claim 2, but defines the material-agitating means as a baffle member disposed in the region of the bin discharge opening. Claim 4 calls for the invention as recited in claim 2, and defines the material-agitating means as an inverted conical baffle member disposed in the region of the bin discharge opening, and further describes the vibration as in a plane normal to the axis of the conical member.

9. Defendant alleges that the claims of the Wahl patent are invalid because anticipated by a prior use device described as the "Wahl heavy duty feeder," by Carrier Patent No. 3,187,884, by defendant's prior use device known as the "Vibra-Portioner" and the Musschoot Patent No.

3,083,811. Alternately, defendant asserts that if these prior art devices and prior art patent do not specifically contain all of the elements of the claims of the Wahl patent, then under Title 35 USC, Sec. 103, the differences, between the subject matter sought to be patented in the Wahl patent and the above cited prior art are such that the subject matter as a whole, would have been obvious at the time the invention was made to a person having ordinary skill in the art to which this subject matter pertains.

10. The facts concerning the Wahl heavy duty feeder:

(a) It is conceded that Vibra Screw sold a heavy duty feeder more than one year prior to the filing of the original application for the Wahl patent (R. 30-32). This heavy duty feeder is shown in defendant's Exhibits AA-1, B, C, D and E. As stated in defendant's Exhibit A-1, one of the purposes of the vibrating portion of the heavy duty feeder is to provide a vibrating baffle plate attached to a feeder trough which constitutes a material-receiving member, and the vibrating baffle plate enters the supply bin to transmit vibration directly into the material, facilitating the flow of material from the supply bin into the feeder. Although this device included a feeder for the volumetric discharge of material from a supply hopper, essentially there is shown in the heavy duty feeder, a material-receiving member positioned below a supply hopper, a vibrated material-receiving member which carries a vibrated material-agitating means position within the material-receiving member, and which material-agitating means is positioned adjacent the discharge outlet of a hopper,

and upon vibration induces the flow of material therefrom. In function and in structure, the vibrating portion of the heavy duty feeder are substantially identical with the structure shown in Figure 4 of the Wahl patent in suit.

(b) During the course of the trial, Mr. Wahl, plaintiff and the owner of the patent here in suit, referred to a difference between the heavy duty feeder and the bin activator shown in his patent, stating that the heavy duty feeder was intended only for use with small bins or hoppers, whereas, his bin activator was intended for use primarily with large hoppers. The Court finds that the specification of the Wahl patent and the claims do not state that the bin activator is intended for use primarily with large hoppers. Wahl conceded that the bin activator of the patent in suit could be applied to very small bins, and that under these circumstances, either the bin activator or heavy duty feeder could be used to induce the flow of material from the bin (R. 276-79). Furthermore, the literature issued by Vibra Screw (Exhibit D) relating to the heavy duty feeder states: "Designed for tonnage rates, it connects to any supply pipe or hopper and will assist flow of material out of such hoppers."

(c) The Court finds that the Wahl heavy duty feeder contains the elements of the claims of the patent in suit. Although element (a) is in the claim defined as a generally conical material-receiving member, the specification of the patent, in Col. 5, states this material-receiving member may be conical, square, rectangular, or any other shape to conform to a particular hopper shape. The material-receiving member of the

heavy duty feeder is therefore the equivalent of the generally conical material-receiving member called for in claim 1.

(d) The Court finds that the claims of the patent in suit may be read on the structure of the heavy duty feeder, and that none of the prior art cited by the Patent Office is as pertinent to the invention claimed in the Wahl patent as the Wahl heavy duty feeder. If the Patent Office, during the prosecution of the application for the Wahl patent, had before it the drawing of the heavy duty feeder (Exhibit B), with the knowledge that the device was on sale in 1959, the Patent Office would not, in the opinion of the Court, have granted any claims in the Wahl application (R. 876-877).

(e) The file history of the application for the patent in suit discloses that the existence of the heavy duty feeder was not called to the attention of the Patent Office.

11. The facts with respect to Carrier patent No. 3,187,884:

(a) This patent was issued June 8, 1965 after the date of issue of the patent in suit, but was based upon an application filed January 26, 1962, prior to the date of filing of the original Wahl application.

(b) Carrier patent No. 3,187,884 (Exhibit KK) is owned by defendant and is prior art to the patent in suit because in the record of this case, Wahl was not able to establish a date of invention for the subject matter of his application as early as January 26, 1962.

(c) The Carrier patent discloses a device which includes a supply hopper supported on vertical supports attached to a base. Under the hopper is a feeder which receives material from the hopper. Extending from this material-receiving means and fixed to it by a rod is a baffle which is vibrated simultaneously with the vibration of the material-receiving means. In operation, material is put into the hopper, the material-receiving means with the material-agitating means are simultaneously vibrated, and since the material-agitating means is positioned adjacent to the outlet of the hopper, by the vibration of the material-agitating means, the material is induced to flow from the hopper into the material-receiving means.

(d) Although, like the Wahl heavy duty feeder, the device of the Carrier patent was initially directed to a feeding apparatus insofar as this device includes a vibrated material-receiving means carrying a vibrated material-agitating means position below a supply hopper, the structure and the function of this portion of the device is substantially identical to the structure and function of the device shown in Figure 4 of the Wahl patent in suit.

(e) The Court finds that the device of the Carrier patent has all of the elements of claim 1, with these elements functioning substantially in the same way to produce substantially the same result in the same way as the device of the patent in suit (R. 826-827).

(f) The Court is of the opinion that if the Patent Office had before it the prior art Carrier patent, it would not have granted the claims in the Wahl patent (R. 877).

12. The facts concerning defendant's Vibra-Portioner device:

(a) Defendant's Exhibit R is literature distributed by defendant in January of 1962, (R. 536-7) prior to any date of invention asserted by Wahl for the device of the patent in suit. Exhibit MM is a portion of the literature issued by defendant showing the structure of the Vibra-Portioner. This device is somewhat different from the device in Carrier patent No. 3,187,884, but in general, performs the same function as the device of that patent. The Vibra-Portioner (Exhibit MM) is a device which induces flow of material from a storage bin and includes a hopper, a material-receiving member vibrationally supported by leaf springs with the material-receiving member carrying a material-agitating member in the form of an upstanding rod and baffle. When vibrated, the material-receiving member and the material-agitating member vibrate simultaneously to induce flow of material from the hopper into the material-receiving means.

(b) The Court finds that the elements of the claims of the Wahl patent are included in the Vibra-Portioner device offered for sale by Defendant in January of 1962, with these elements functioning in substantially the same way to produce substantially the same result as the device shown and described in the Wahl patent (R. 861-883).

13. The facts concerning Musschoot patent No. 3,083,811:

(a) The application for the Musschoot patent was filed July 2, 1959, and is prior art to the patent in suit. Defendant's Exhibit LL-2 is the Musschoot patent and LL-1 is a colored chart containing some of the

figures of this patent together with material from the specification of the Musschoot patent.

(b) In the Musschoot patent there is disclosed a silo or hopper with sloping sides terminating in a discharge portion. Positioned below the hopper is a material-receiving member, and extending upwardly from the material-receiving member is a material-agitating member which is vibrated simultaneously with the material-receiving member for the purpose of inducing flow of material from the hopper into the material-receiving member. The Musschoot patent states in the specification that the problem to be solved by the device of the patent was inducing the flow of materials which are difficult to handle from a discharge outlet of the hopper. Reference is made in this patent to the problem presented by arching of hard-to-handle materials.

(c) The Court finds that because the vibratory bin feeder of Musschoot patent No. 3,083,811 includes a material-agitating means carried by a vibrating material receiving member positioned below a supply hopper with the material agitating means extending into the hopper to induce flow of material therefrom, there is included the basic elements of the claims of the Wahl patent, and these elements in the Musschoot device function in the same way as the bin activator in the Wahl patent to produce substantially the same results.

(d) The Court finds that the art cited by the Patent Office was not as pertinent to the claims of the Wahl patent as the device described in the Musschoot patent, and that if the Patent Office had considered the Mus-

school patent during the prosecution of the application for the Wahl patent, it is the opinion of the Court that claims of the scope of the claims in the Wahl patent would not have been granted by the Patent Office (R. 859-861).

14. Plaintiff Wahl testified that his invention differed from the prior art and referred to a chart (Exhibit 42) which he stated showed a compaction zone adjacent the discharge outlet of the hopper, and within the material-receiving means, and that none of the prior art devices included such a compaction zone. He stated that the bin activator of his patent in suit differed from the prior art devices in that it was intended for use with large hoppers and not for use with small hoppers. The Court finds that this attempted differentation from the prior art was not based upon the structure called for by the claims of the Wahl patent, but upon a general re-definition of what Wahl considered his invention to be. For purposes of avoiding the prior art, Wahl very narrowly construed what he considered to be his invention by placing the material-agitating means and the material-receiving means in a specific location, referred to by him as the compaction zone, but, for purposes of infringement and attempting to read the claims upon certain of defendant's devices, he ignored these specific limitations and gave to the claims a much broader interpretation.

15. The differences between the subject matter sought to be patented in the Wahl patent and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains.

(a) *The scope and content of the prior art.*

The prior art relied upon by defendant discloses that as of the earliest date of the filing of the application for the Wahl patent, it was old to have a material-receiving means carried by and positioned below a hopper with a material-agitating means carried by and vibrated simultaneously with the material-receiving means. It was old to place the material-agitating means within the material-receiving means and adjacent the discharge outlet of a supply hopper. The prior art devices all functioned to induce flow of material from the hopper by the material agitating means into the material-receiving means from which it was discharged. In apparatus and in function, this is essentially the same as the device of the patent in suit.

(b) *The level of the ordinary skill in the pertinent art.*

The Court finds from the record in this case, and the prior art devices referred to above, that at the time the Wahl asserted invention was made the art of vibration to induce material to flow from a hopper was well known. The level of the skill at that time was such that it was known, or obvious, to a person of ordinary skill in the art to induce flow from a hopper by the use of vibrating material receiving means which carries a vibrating agitating means position within a hopper adjacent to the outlet end of a hopper or just below the discharge end of a hopper, whereby the simultaneous vibration of the material-agitating means and material-receiving means would induce flow of hard-to-handle material from the hopper, thus preventing the bridging or arching of material within

the hopper. The witness Dumbaugh, an employee and officer of defendant corporation, testified that he was first employed by defendant on August 1, 1962 when the corporation had few employees, and that his prior experience did not include any information relative to bin activators, feeders or other vibrating devices. Upon becoming employed by defendant, his initial project was to improve the Vibra-Portioner, then being sold by defendant, and without any experience in the vibrator field, and within a matter of six weeks (Exhibit T), he had developed a device substantially identical with that shown in the Wahl patent functioning in the same way to produce the same result. The Court finds from this evidence it is established that to a person of less than ordinary skill in the art, the device shown and described in the Wahl patent, functioning in the same way to produce the same result, could be developed within a relatively short period of time from the time the problem was first encountered.

16. There is an assertion that defendant's accused vibrating hoppers were copied from plaintiffs' commercial device, and the Court finds, as a fact, that Dumbaugh, an employee of defendant corporation, completed the design of the prototype, which ultimately became defendant's feeders, as early as September 16, 1962, when he modified the Vibra-Portioner then being sold by defendant (Exhibit T) (R. 548-550). Prior to this time he had not seen any of the literature issued by plaintiff (R. 531-33). Some reference has been made to the proposed sale by plaintiff of a feeder to the Austin Company, but the Court finds, as a fact, that the first contact defendant had with the Austin Company job was November 9, 1962, after defendant had completed its modified version

of its Vibra-Portioner (R. 653-688). The hoppers made by defendant herein charged to infringe were developed independently by defendant.

17. Carrier Reissue Patent No. 26,291 plays a very important role in the consideration of this case. This is a reissue of patent No. 3,187,884 heretofore referred to as one of the prior art patents.

(a) At the time defendant's counsel was retained by defendant in this case, the existence of the Carrier patent owned by defendant was called to his attention. An examination of this patent and the file history thereof disclosed that although the specification and the drawings showed a material-receiving member carrying a material-agitating member positioned below a hopper, and induced the discharge of material from the hopper to the material-receiving means by the simultaneous vibration of the material-receiving means and the material-agitating means, no claims to this concept were included in the original application. The reissue statute, Title 35 U.S.C., Sec. 251, provides for the reissue of patents under certain circumstances, and because the time limit for the filing of a reissue application had not expired, it was determined that an application for reissue of this Carrier patent should be filed, and this was done.

(b) The application for Carrier patent No. 3,187,884 and the application for the patent in suit were both pending in the Patent Office at the same time. The Patent Office rules provide that, where there are two pending applications disclosing or claiming the same or similar subject matter, an interference will be declared to determine who is the first inventor of the sub-

ject matter. The file history of both the Carrier patent No. 3,187,884 and Wahl patent No. 3,173,583 disclose that no interference was declared.

(c) Based upon the record in this case, it is the Court's opinion that, if the Patent Office had declared an interference between the application for the Carrier patent and the application for the patent in suit, Carrier should have been determined to be the prior inventor, and the claims directed to the common subject matter,—i.e., the concept of providing a material-receiving means vibrationally supporting a material-agitating means positioned below a supply hopper would have been awarded to Carrier, and no claims would have been awarded to Wahl.

(d) The fact that the Patent Office granted the Carrier reissue patent with claims dominating the structure shown in the Wahl patent in suit is evidence that the Patent Office, with its expertise, considers that the subject matter disclosed in the original Carrier patent is substantially identical with the disclosures in the Wahl patent in suit.

18. Notwithstanding the foregoing findings of fact holding invalid the claims of the Wahl patent in suit, and notwithstanding the generally accepted rule that an invalid patent may not be infringed, for purposes of completeness, findings will be made concerning the infringement of the claims of the Wahl patent by the various devices made and sold by defendant.

(a) Testimony was offered concerning infringement and the infringement of the claims in the patent in suit by the witness Wahl who, as conceded by plaintiff's counsel, was not an expert in reading patent

claims (R. 1191). On this matter of infringement and claim interpretation, defendant offered testimony through the witness Fischer, whose background included being a Professor of Engineering, a Dean of Engineering at a University, a law school graduate, and some years in practice as a patent lawyer with admission to practice before the United States Patent Office (R. 750-755).

(b) For purposes of construing the claims of the Wald patent, and because of the assertion of a file wrapper estoppel, the Court has given consideration to the prosecution history of the application for the patent in suit. Exhibit AA-1 illustrates that claim 1 of the patent in suit, as originally filed in the application, broadly discloses the material-agitating means as being spaced from the inner wall of the conical member, and rigidly secured thereto without any specific location of the material-agitating means with respect to the conical member. By a Patent Office rejection of January 28, 1964, the Examiner rejected this claim for the reason that the location of the agitating means was recited so broadly that it read upon one of the elements of the prior art Rouse patent. After this rejection, this claim was amended to locate the agitating means as "being disposed within said conical member and extending substantially to the said inlet opening thereof." The Court finds that in order to avoid prior art, the agitating means was specifically located as being within the conical member and extending substantially to the said inlet opening thereof.

(c) The vibrating hoppers sold by both plaintiff and defendant have the material-agitating means located at varying positions with respect to the inlet

opening. Sometimes the apex of the cone or baffle, which constitutes the material-agitating means, is positioned substantially below the inlet opening, and in other devices, this material-agitating means is positioned substantially below the inlet opening of the cone member or material-receiving means. In the light of the prosecution history, and the file wrapper estoppel just referred to, the Court finds there is infringement of these claims only if the apex of the cone or the material-agitating means comes within one inch of the inlet opening (R. 889-892). There are some such devices made and sold by defendant, and if the claims are valid, such devices infringe the claims of the patent in suit.

Conclusions of Law

1. In this case the patent in suit is not entitled to the usual presumption of validity because the prior art relied upon in this case was not cited or considered by the Patent Office.

2. The claims of the patent in suit are invalid because anticipated by the heavy duty feeder sold by Vibra Screw more than one year prior to the filing of the original application for the patent in suit.

3. The claims of the Wahl patent are anticipated by the disclosure of Carrier patent No. 3,187,884 and by the Vibra-Portioner sold by defendant prior to any date of invention asserted by Wahl in this case.

4. The claims of the patent in suit are anticipated by Misschoot patent No. 3,083,811.

5. Alternately, and in addition to the anticipation referred to above, on the question of obviousness, under

Title 33 USC, Sec. 103, the Conclusion of Law is reached that the differences between the subject matter sought to be patented in the Wahl patent and the prior art referred to above are such that subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains.

6. Although plaintiffs have established some commercial success of the devices covered by the patent in suit, such commercial success cannot in a case such as this, render valid a patent otherwise invalid. In any event, commercial success may be used only where there is some doubt as to the validity of a patent. Good and valid patents do not need commercial success to sustain them. Invalid patents cannot be helped by commercial success.

7. Although an invalid patent may not be infringed, the Court finds that if the claims of the patent in suit are valid they are infringed only by each of the devices made and sold by defendant wherein the apex of the cone or material-agitating means comes within one inch of the inlet opening of the vibrating material-receiving means, and this finding is based upon the file wrapper estoppel heretofore referred to.

8. A patent application has a duty to the Patent Office to make a full and fair disclosure of all of the facts which may affect the patentability of his invention. Wahl was under a duty during the prosecution of his application for the patent in suit to disclose to the Patent Office the existence of the heavy duty feeder because this prior art device was much closer to his asserted invention than anything cited by the Patent Office. The failure to call attention to the heavy duty feeder constitutes a fraud on

the Patent Office, and the maintenance of this suit based upon the acceptance of a patent resulting from fraud upon the Patent Office makes this an exceptional case.

9. By virtue of the foregoing conclusion of fraud upon the Patent Office, defendant is entitled to an award of attorney's fees in this case.

WILLIAM E. STECKLER
United States District Judge

Dated: November 5, 1969

APPENDIX C

IN THE
UNITED STATES COURT OF APPEALS
For The Seventh Circuit
Chicago, Illinois 60604.

Monday, August 30, 1971

Before
Hon. J. EARL MAJOR, *Senior Circuit Judge*
Hon. THOMAS E. FAIRCHILD, *Circuit Judge*
Hon. WILBUR F. PELL, JR., *Circuit Judge*

EUGENE A. WAHL and VIBRA SCREW FEEDERS, INC.,
Plaintiffs-Appellants,
vs.
No. 18324
CARRIER MANUFACTURING CO., INC.,
Defendant-Appellee.

Appeal from the United States District Court for the Southern District of Indiana, New Albany Division.

This cause came on to be heard on the transcript of the record from the United States District Court for the Southern District of Indiana, New Albany Division, and was argued by counsel.

On consideration whereof, it is ordered and adjudged by this court that the judgment of the said District Court adjudicating and decreeing the claims of the patent in suit invalid and dismissing plaintiff's complaint for infringement thereof, in this cause appealed from be, and the same is hereby, Affirmed, with costs, in accordance with the opinion of this Court filed this day.

APPENDIX D

In The
United States Court Of Appeals
For The Seventh Circuit
Chicago, Illinois 60604

Tuesday, November 2, 1971

Before
Hon. Thomas E. Fairchild, *Circuit Judge*
Hon. J. Earl Major, *Senior Circuit Judge*
Hon. Wilbur F. Pell, Jr., *Circuit Judge*

EUGENE A. WAHL and VIBRA SCREW FEEDERS, INC., Plaintiffs-Appellants, vs. CARRIER MANUFACTURING CO., INC., Defendant-Appellee. No. 18324	Appeal from the United States District Court for the Southern District of Indiana, New Albany Division.

It Is Ordered by the Court that the petition for rehearing filed in the above-entitled cause be, and the same is hereby denied.

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No. 71-967

In the
Supreme Court of the United States
OCTOBER TERM, 1971

EUGENE A. WAHL and
VIBRA SCREW FEEDERS, INC.,
Petitioners,

vs.

CARRIER MANUFACTURING CO., INC.,
Respondent.

BRIEF FOR RESPONDENT IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

THOMAS F. McWILLIAMS,
53 West Jackson Boulevard
Chicago, Illinois 60604
Attorney for Respondent

The Scheffer Press, Inc.—(312) 263-6850

IN THE

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1971

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EUGENE A. WAHL and
VIBRA SCREW FEEDERS, INC.,

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Respondent.

BRIEF FOR RESPONDENT IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

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1. Findings of the Trial Court and the Appellate Court

This is a run-of-the mill patent infringement case. Petitioners charged Respondent with infringement of patent No. 3,173,583 for a "bin activator". After the usual discovery proceedings, the case came on for trial before Judge Steckler in the United States District Court in Indianapolis. As stated by the 7th Circuit Court of Appeals (Appendix 12a),* the trial court heard voluminous testimony in a trial which lasted eight days. The testimony principally involved the testimony of Wahl and Fischer

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* Reference in this brief will be made to the Opinion of the 7th Circuit Court of Appeals and to the Findings of Fact and Conclusions of Law as they appear in the Appendix to the Petition for the Writ of Certiorari.

in their capacity as experts testifying in great detail in explanation of many physical exhibits, the prior art cited by the Patent Office, and that not cited by the Patent Office but relied upon by defendant. As indicated in the Opinion of the Court of Appeals (Appendix 8a), the trial court was called upon to consider the testimony of the two principal witnesses, Wahl and Fischer, and it appears that the District Court rejected the testimony of Wahl and credited the testimony of Fischer.

Before the Court of Appeals, Petitioners urged that the trial court did not understand the concept of the Wahl invention and that the court was misled by Respondent's expert, Fischer. Relative to his assertion by Petitioners, the Court of Appeals stated:

> "The record refutes the suggestion that Judge Steckler was led astray. It reveals that he was keenly aware of the issues for decision and the contentions of the respective parties, and actively participated in the examination of the expert witnesses. * * *" (Appendix 9a)

The court entered Findings and Conclusions of Law which although prepared by counsel for Respondent, was substantially modified to conform with the court's suggestions. These Findings of Fact with respect to the validity and infringement of the patent here in suit were affirmed by the Court of Appeals.

An examination of the Findings of Fact of the trial court discloses that the court (Appendix 33a) described the device disclosed in the patent in suit, referred to the claims thereof and considered what is alleged to be the invention disclosed by these claims (Appendix 33a-35a). The trial court then considered one of the prior use devices asserted by defendant to be an anticipation of the patent in suit (Ap-

pendix 35a-38a) described the structure of the device, how the structure was related to the elements set forth in the claims of the patent in suit, referred to the fact that this prior art device made and sold by Petitioners was not called to the attention of the Patent Office, and concluded that this heavy duty feeder made and sold by Petitioners comes within the claims of the patent in suit and it therefore anticipated. The trial court also found that if the Patent Office was aware of the existence of this heavy duty feeder as a prior art device, the Patent Office would not have granted any claims in the application for the patent in suit (Appendix 37a-38a).

In the same manner the court considered the non-cited Carrier patent No. 3,187,884 and Respondent's commercial product of the structure shown generally in this patent both of which constituted prior art to the patent in suit, and concluded that the Carrier patent and the prior art device made in accordance therewith anticipated the claims of the patent here in suit (Appendix 38a-39a).

The trial court in its findings considered the Musschoot patent No. 3,083,811, and described what is shown in that patent and concluded that all of the elements of the claims of the patent here in suit could be found in the Musschoot patent, functioning in the same way to produce substantially the same result as that produced by the structure of the patent in suit, and found that the Musschoot patent constituted an anticipation of the claims of the patent in suit (Appendix 40a).

In the Findings of Fact of the Trial Court (Appendix 43a-44a) the court determined the scope and content of the prior art, the level of the ordinary skill in the pertinent art, and concluded that at the time the asserted invention

was made, the subject matter thereof would have been obvious to a person of ordinary skill in the art.

From a reading of these findings of the trial court it is apparent that the trial court found that the invention claimed in the claims of the patent in suit was anticipated by the Wahl heavy duty feeder made and sold by Petitioners, was anticipated by Carrier patent No 3,187,884 and by the commercial embodiment of that device made and sold by Respondent, that the claims of the patent in suit were anticipated by Musschoot patent No. 3,083,811, and that to the extent there are any differences between the subject matter of the claims and these prior art devices and patents, the subject matter claimed in the patent in suit would have been obvious at the time the invention was made to a person having ordinary skill in the art. The finding of invalidity of the claims of the patent in suit was therefore predicated upon both anticipation under Title 35 U.S.C. Sec. 102 and upon obviousness under Title 35 U.S.C. Sec. 103.

The trial court, notwithstanding its finding of invalidity of the patent in suit, considered the question of Respondent's infringement of the claims and based upon a resolution of conflict of testimony before it, concluded that because of file wrapper estoppel during the prosecution of the patent in suit, the claims should be limited in a manner such that many of the devices charged to infringe actually did not infringe, but held that certain of the devices would infringe the claims of the patent in suit if these claims were valid (Appendix 44a-48a).

All of these matter were given adequate consideration by the Court of Appeals in its opinion, and the court affirmed the decision and judgment of the trial court with respect to anticipation, obviousness and infringement.

2. There is No Reason For the Grant of Certiorari In This Case

Rule 19 of the Rules of the Court sets forth generally the reasons for which this court may grant certiorari. With respect to Rule 19-1, it is not applicable here since there is no State Court decision involved and there is not even any attempt to show herein that the decision of the Court of Appeals in this case has decided an important question in a way in conflict with the applicable decision of this court. Certainly there is no conflict of decisions of different Courts of Appeals with respect to the validity of the patent in suit. There is therefore no showing under Rule 19 that certiorari should be granted in this case.

In the Petition for the writ, Petitioners assert that the trial court and the Court of Appeals interpreted the claims of the patent in one way for purposes of novelty, and another way for purposes of infringement. Throughout the course of the trial at the trial court level, and in the Court of Appeals, Petitioners consistently urged that for purposes of avoiding the prior art, the claims should be very narrowly construed, but for purposes of infringement to cover all of the varying devices made by Petitioners, the claims were entitled to a very board interpretation. This was referred to in Finding 14 (Appendix 42a) wherein it stated:

> "For purposes of avoiding the prior art, Wahl very narrowly construed what he considered to be his invention by placing the material-agitating means and the material-receiving means in a specific location, referred to by him as the compaction zone, but for purposes of infringement and attempting to read the claims upon certain of defendant's devices, he ignored these specific limitations and gave to the claims a much broader interpretation."

It thus appears that reason No. 1 (Petition, Page 10) asserted for granting the writ was completely and adequately resolved by the trial court based upon a conflict of testimony as to the scope of the claims in the light of the prior art presented.

The Court of Appeals stated:

> "Thus, the trial court was confronted with the testimony of two knowledgeable witnesses who in some respects were in wide disagreement as to what Wahl had invented, as disclosed by his patent, and the disclosure of the prior art. It was that court's function, not ours on review, to weigh the conflicting testimony and judge of the credit to be given the witnesses. We are satisfied that the court properly performed its duty in this respect. Certainly we cannot hold that the finding was clearly erroneous under Rule 52(a)." (Appendix 16a).

It is thus abundantly clear that reason No. 1 asserted in the Petition for granting the writ involves only a determination by the trial court and the Court of Appeals based upon a resolution of conflicting testimony.

On page 13 of the Petition, as reason No. 2 for the grant of the writ, it is asserted that the decisions of the courts below are in conflict with the decision of this Court as to the manner of determining obviousness under Sec. 103 of the patent statutes. Petitioners assert that the District Court did not make note of the differences between the patent claims and the prior art and then determine the obviousness of the advance made by the patentee. This assertion by Petitioners completely ignores the fact that in the opinion of the trial court there are specific findings holding the claims of the Wahl patent to be anticipated by the Wahl heavy duty feeder, the Carrier patent and

the commercial embodiment of the Carrier patent and by the Musschoot patent. In the Petition there is no attack upon these findings of anticipation, and this being so, there was really no reason why the court should get to a resolution of the question of obviousness under Sec. 103 of the patent statutes. Nevertheless, the court did so, and carefully following the mandate of this Court in *Graham* v. *John Deere* (383 U.S. 1), determined the facts with respect to each of the prior art devices and patents relied upon (Appendix 36a-42a), determined the scope and content of the prior art (Appendix 43a), determined the level of the ordinary skill in the pertinent art (Appendix 43a), and stated in Conclusion of Law 5 (Appendix 48a) that notwithstanding the holding of anticipation on the question of obviousness under Title 35 U.S.C. Sec. 103, the conclusion is reached:

> ". . . that the differences between the subject matter sought to be patented in the Wahl patent and the prior art referred to above are such that subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains."

In the Petition (Page 13) there is a statement that the actual basis for the conclusion of obviousness is drawn from a finding by the trial court that an employee of Respondent arrived at the same solution independently. This the trial court did, but this reason for a holding of obviousness was only in addition to the basic ground of obviousness over the prior art referred to by the trial court. If the trial court had not referred to this additional bit of evidence in establishing obviousness, the basic finding of the court with respect to obviousness would

still stand. The Petition in this aspect presents no reason for the grant of the writ.

As indicated by the Court of Appeals (Appendix 8a), the District Court resolved the problem before it by weighing the testimony of the two experts who testified at length before the trial court and made its determination on the question of validity and infringement. As the Court of Appeals stated (Appendix 12a) the court heard voluminous testimony in a trial which lasted eight days. It thus appears that Petitioners had every opportunity to present their case to the trial court wich after thorough consideration entered judgment against Petitioners. The judgment of the trial court was considered and affirmed by the Court of Appeals in a lengthy opinion which discussed all of the arguments advanced by Petitioners.

What the Petitioners would really like to have this Court do is to grant the writ and consider de novo all of the facts presented to the trial court with the hope that this court would reach a different conclusion upon an analysis of these facts.

There is no valid reason asserted in the Petition for this Court to grant a writ of certiorari in this case, and it is submitted that the Petition should be denied.

Respectfully submitted,

THOMAS F. MCWILLIAMS
53 West Jackson Boulevard
Chicago, Illinois 60604
Attorney for Respondent

In the appendix to the Petition herein Conclusions of Law 8 and 9 are set forth at pages 49a and 50a. These relate to fraud on the Patent Office and the allowance to defendant of attorney's fees in this case. This is the original form of Judgment entered by the trial court on November 5, 1969, but attention is called to the joint appendix filed in the Court of Appeals, page 31a, wherein an order was entered amending the courts conclusions of law and wherein paragraph 9 was stricken and paragraph 8 modified to exclude a finding of fraud on the Patent Office.

SUPREME COURT, U. S.

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FILED
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E. ROBERT SEAVER, C.

No. 71-967

In the
Supreme Court of the United States
OCTOBER TERM, 1971

EUGENE A. WAHL and
VIBRA SCREW FEEDERS, INC.,
Petitioners,

vs.

CARRIER MANUFACTURING CO., INC.,
Respondent.

REPLY BRIEF OF PETITIONERS IN SUPPORT OF THE PETITION FOR THE WRIT OF CERTIORARI

EDWARD A. HAIGHT
JOHN W. HOFELDT
Attorneys for Petitioners

Of Counsel:
HAIGHT, HOFELDT & DAVIS
141 West Jackson Boulevard
Chicago, Illinois 60604

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Respondent does not dispute that the District Court construed the same claims of the patent in suit one way for purposes of novelty and another for purposes of infringement or that the Court of Appeals approved of this diverse claim interpretation.

Neither does Respondent dispute the importance that uniform interpretation of patent claims has to the respective rights of the public and patentees.

Respondent argues (Brief, p. 6) that consistent claim interpretation is not an important issue because it "was completely and adequately resolved by the trial court

based upon a conflict of testimony as to the scope of the claims in the light of the prior art presented."

This only magnifies the importance of the first question presented by the Petition. Is there not even greater urgency for this Court to speak on the question when lower courts are of the view that the interpretation of patent claims is not a legal but a factual matter to be resolved by weighing the testimony of witnesses and, further, that diverse interpretations of the same claims are permissible when the testimony directed to them on the validity issue is inconsistent with that on the infringement issue?

Respondent in its response to the second reason urged by the Petition for granting the Writ does not contend that the District Court found the differences between the prior art and the claims at issue as required by Section 103 of the Patent Act and the decision in *Graham* v. *John Deere*, 383 U.S. 1. Instead, Respondent argues that it was unnecessary to do so because of the findings that the claims in suit were anticipated.

The *Graham* decision gives no indication that obviousness can be determined other than by strict observance of the requirements of the statute. Had the factual inquiries required for the obviousness issue been made in the instant case the trial court would have discovered that on the anticipation issue it had: (1) broadened the claims beyond their terms and even beyond the scope of the subject matter of the specification of the patent, and (2) that the prior art which the claims were broadened to encompass was concerned with devices which operated only after the problem to which the patent in suit is directed had ceased to exist. It would also have been

discovered that such prior art further differed from the claimed subject matter in that it did not respond to clear limitations in the claims, including one inserted after rejection of broader claims by the Patent Office.

Respondent points also to conclusionary findings made by the District Court on the issue of obviousness. This is no answer. This Court, in *Graham*, pointed out that "several basic factual inquiries" must be made as a basis for a conclusion on obviousness. One of them is the "differences between the prior art and the claims at issue." (383 U.S. at 17).

The mandate of *Graham* is eroded if conclusions are to be substituted for such "basic factual inquiries" and subjective tests, such as alleged independent development, are to be permitted as a basis for determining obviousness. Clearly the interposition of this Court is required.

Respectfully submitted,

EDWARD A. HAIGHT
JOHN W. HOFELDT
Attorneys for Petitioners

Of Counsel:
HAIGHT, HOFELDT & DAVIS
141 West Jackson Blvd.
Chicago, Illinois 60604